REMARKS

Claims 1-11 and 13-28 are pending in this application.

Claims 1, 10, 11, 16, 22, and 28 are independent.

Claims 1, 10, 11, 16, 22, and 28 stand rejected under 35 USC §112, second paragraph, as being indefinite. Claims 1-11 and 13-28 stand rejected under 35 USC §103(a) as obvious over Kight et al. (U.S. Patent 5,383,113) in view of Pollin (U.S. Patent 5,504,677) and Official Notice that certain recited features are well known in the art. The rejections are respectfully traversed.

This application was filed December 12, 1997. In the FOUR years this application has been under prosecution it has been the subject of five Official Actions and an Appeal. As has been repeatedly discussed, the claims of this application are not anticipated by, or obvious in view of, any of the prior art yet relied upon by the Examiner. Because prior art does not teach or suggest the claims of the present invention, the Examiner continues to rely upon unsupported Official Notice in rejecting each independent claim, and other unsupported Official Notices in rejecting various ones of the dependencies. Furthermore, the Examiner has refused to provide any support whatsoever for the Official Notices.

Now, in the most recent Official Action, the Examiner rejects the independent claims upon new grounds, namely, 35 USC §112, second paragraph. It is respectfully submitted that this evidences a continued lack of understanding of the present invention.

Furthermore, it is respectfully submitted that the finality of the present rejection is premature. The Examiner's attention is courteously directed to MPEP 706.07 for a discussion of final rejections. As clearly required by the MPEP, "[b]efore final rejection is in order a clear issue should be developed between the Examiner and applicant."

2

The Examiner's attention is particularly directed to MPEP 706.07(a) - Final Rejection, When Proper on Second Action. According to the MPEP, a final rejection is improper when "the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement."

The 35 USC §112, second paragraph, rejection of claims 1, 10, 11, 16, 22, and 28 has been made by the Examiner for the first time in the most recent Official Action (Paper No. 21). This rejection was not necessitated by an amendment of the claims, nor by submission of an information disclosure statement, as none of claims 1, 10, 11, 16, 22, or 28 were amended by the prior Amendment (filed July 24, 2001), and as no Information Disclosure Statement has been submitted since before the prior Official Action of May 4, 2001 (Paper No. 18).

Accordingly, for at least this reason and to the extent that the Examiner intends to maintain the 35 USC §112, second paragraph, rejection of claims 1, 10, 11, 16, 22, and 28, it is respectfully requested that the Examiner withdraw the finality of the rejection.

In the prior Official Action dated May 4, 2001 (Paper No. 18), the Examiner acknowledged that the art relied upon to reject independent claims 1, 10, 11, 16, 22, and 28 (Kight and Pollin) under 35 USC §103(a) does not teach or suggest certain recited limitations. To overcome this deficiency in the art, the Examiner relied upon Official Notice that such limitations were old and well known in the art. In response to the taking of Official Notice, in the Amendment of July 24, 2001 it was requested that the Examiner "produce and apply prior art, combinable with the applied base combination of art, which will support the Official Notice. In particular, it is requested that the Examiner produce and apply prior art which discloses processing payment

information, other than a received zip code, to identify an eleven digit zip code."

Additionally, in Paper No. 18, the Examiner acknowledged that Kight and Pollin fail to teach or suggest certain recited limitations in various dependent claims and relied on Official Notice in rejecting these claims. The Examiner was also requested, in the Amendment of July 24, 2001, to provide support for these Official Notices.

In the most recent Official Action (Paper No. 21), the Examiner refuses to provide support for the Official Notices. The Examiner argues, "applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner's taking of Official Notice has been maintained." The Examiner points to MPEP 2144.03 for support of this position.

It is respectfully submitted that the Examiner has misapplied the teachings of MPEP 2144.03. In particular, it is Office policy that "[i]f the applicant traverses an [Official Notice] the examiner should cite a reference in support of his or her position." Such applicant traversals should be seasonable. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made."

It seems that the Examiner has taken the MPEP's discussion of *Judicial Notice* taken by the Board of Patent Appeals and Interferences and applied it to *Official Notice* taken by an Examiner. In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) teaches that an applicant must seasonably challenge *Judicial*

Notice taken by the Board, such seasonable challenge creating on its face a reasonable doubt regarding the circumstances justifying the Judicial Notice. <u>Boon</u> does not require that an applicant create reasonable doubt regarding the circumstances justifying Official Notice. Furthermore, it is believed that the challenge made does, in fact, on its face create a reasonable doubt as to the justification for the Official Notice.

Because the Examiner has not cited and applied prior art in support of the Official Notice, as seasonably requested by the Applicant's representatives in the Amendment of July 24, 2001, it is courteously submitted that the finality of the rejection of claims 1-11 and 13-28 is premature and improper.

Accordingly, it is respectfully requested that the Examiner withdraw the finality of the 35 USC §103(a) rejection of claims 1-11 and 13-28 and cite and apply prior art in support of the Official Notices.

In regard to the 35 USC §112, second paragraph, rejection of claims 1, 10, 11, 16, 22, and 28, the Examiner argues "the term 'payee zip code' is vague and indefinite. It is confusing to the examiner as to why this term is used in the claim since the 'payee zip code' is not used for anything. In the present invention, all records are based on the payee zip code, however, since the payee zip code is not an eleven-digit zip code, it can not be used to access the payee database."

It should first be noted that claims 10 and 22 do not recite a "payee zip code," or any derivative thereof. Thus, the 35 USC §112, second paragraph, rejection of claims 10 and 22 is not understood. It should also be noted that the independent claims do not necessarily require, as the Examiner asserts, that "all records" be "based on the payee zip code," and that the recited payee zip code not be an eleven-digit zip code.

The Examiner's attention is once again courteously directed to the Summary of Invention section of the Appeal Brief, beginning on page 2, for a concise description of the present invention, including a discussion of each claim.

At stated in MPEP 2173, "the primary purpose of" the "requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." Further, applicants "can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art." "Applicant may use … any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought."

The definiteness of a claim should be analyzed in light of the content of the application, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. (See MPEP 2173.02)

As to independent claims 1, 11, and 16, these claims each require, at least in part, 1) stored payee records (with, in claims 1 and 11, each payee record having a payee zip code), 2) receiving a payor's payment information, including a payee zip code, 3) processing the payee information, *other than* or *excluding the received payee zip code* to identify or produce an *eleven digit zip code* for a payee, and 4) locating or retrieving at least one payee record corresponding to the *identified* or *produced eleven-digit zip code*.

It is respectfully submitted that the use of the phrase "payee zip code" in claims 1, 11, and 16 is not "vague and indefinite." Rather, a proper construction of claims 1, 11, and 16, as well as the clear language, clearly yields the definite

6

requirements that a "payee zip code" be received as a part of a payor's payment information, that the received "payee zip code" then <u>not</u> be utilized in identifying or producing "an eleven-digit zip code for the payee", and thus <u>not</u> utilized in locating or retrieving a stored payee record. The scope of these claims would be clear to one of ordinary skill in the art.

In answer to the Examiner's question concerning the reason for inclusion of the phrase "payee zip code," this phrase, which refers to the zip code received as a part of the payor's payment information, is used in these claims to clearly define that a zip code received as a part of a this information is <u>not</u> used to locate or retrieve stored payee records.

As to independent claim 28, this claim requires, in part, 1) a stored database of payee records, each payee record including stored name information and stored address information, including a zip code, 2) receiving payee name and address information, including a zip code, 3) determining if stored payee name and address information correspond to the received payee name and address information, 4) if not, processing the received payee address information to identify an eleven digit zip code, and 5) determining if a *stored* payee zip code corresponds to the *identified* eleven-digit zip code. Thus, required by this claim are 1) a stored zip code, 2) a received zip code, and 3) an identified eleven-digit zip code.

It is respectfully submitted that claim 28 is not indefinite. According to the clear and definite language of claim 28, a person of ordinary skill in the art would read the claim to require, in part, a database including <u>stored</u> zip codes, receiving address information, including a <u>received</u> zip code, processing the received address information to identify an <u>eleven-digit</u> zip code, and determining if a <u>stored</u> zip code corresponds to the <u>eleven-</u>

<u>digit</u> zip code.   It is respectfully submitted that there is no vague or indefinite language in claim 28.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §112, second paragraph, rejection of independent claims 1, 10, 11, 16, 22, and 28.

As to the 35 USC §103(a) rejection of claims 1-11 and 13-28, the Examiner's positions on these claims are substantially the same as the basis for rejection in the prior Official Action dated May 4, 2001.   It is respectfully requested that the Examiner reconsider the arguments previously submitted in response to the Official Action of May 4, 2001, as well as those made below, and withdraw the rejection of the claims.

The Examiner's clarification of the rejection of claims 2, 17, and 25 is noted with appreciation.   However, the Examiner's position is still not understood.   Claims 2 and 17 require that only a portion of received address information, and not the received payee zip code, be processed to identify an eleven digit zip code for the payee.   Claim 25 requires that received payment information which is processed to produce an eleven digit zip code for the payee include a portion of a payee name and a portion of a payee address.

The Examiner has failed to adequately explain how Kight, which the Examiner has previously acknowledged fails to teach processing payment information to identify or produce an eleven digit zip code, can possibly disclose processing only a portion of received payee information to identify or produce an eleven digit zip code.

The Examiner points to Kight at column 2, lines 45-47, as disclosing the recited limitations.   Disclosed at column 2, lines 45-47, is a database of information associated with a consumer (payor).   As the Examiner states, this information includes the consumer's name, address, and telephone number.   This consumer

8

information is not associated with, and does not otherwise concern, payees.

The Examiner argues "The payee address is analogous to both the payee zip code and the payee address information since the address includes a zip code. Since one can input consumer address information to access payment information, this means that consumer address information is affiliated with payment information. Once payment information is processed and accessed, it will include the consumer address information."

The Examiner's reasoning is not understood. Inputting consumer information to access payment information, whatever this is intended to mean, is simply not disclosed in Kight. Furthermore, what relevance this would have to claims 2, 17 and 25 is not understood. Also, the Examiner has not even addressed the requirement that only a portion of information be processed to identify an eleven digit zip code. The rejection of claims 2, 17, and 25 has not been clarified in the present Official Action.

As to claims 3, 4, 5, 18, 19, 26, and 27, the Examiner maintains the prior grounds for rejection (Kight in combination with Pollin) arguing the "rejection is valid since Kight establishes merchant information at the time of payment. This merchant information includes a merchant address which includes the merchant zip code."

While it is acknowledged that Kight discloses utilizing merchant information in making payment on behalf of a payor, it is not understood how this cures the defects in the applied art noted above.

As to claim 3 in particular, as discussed above, the Examiner acknowledges that neither Kight nor Pollin, nor a combination thereof, discloses processing information to identify or produce an eleven digit zip code. The Examiner relies upon Official Notice for such feature. Therefore, it is not understood upon

what basis the Examiner argues that Kight discloses processing payee city and payee state information to identify the eleven digit zip code.

As to claims 4, 5, 18, 19, 26, and 27, the Examiner acknowledges that Kight does not teach the required limitations, and looks to Pollin. However, the Examiner has yet to reference any portion of Pollin which discloses the requirements of claims 4, 5, 18, 19, 26, and 27. The Examiner's attention is courteously directed to the discussion of Pollin found in the response of July 24, 2001.

As to claims 6, 7, and 13, the Examiner solely relies upon the rejection of Paper No. 18. No new reasoning in support of the rejection has been offered.

The Examiner's clarification of the Official Notice regarding claims 8, 14, 20, and 23 is noted with appreciation. As now understood, the Examiner takes Official Notice of a storage device, not alteration and/or validation rules stored therein, as required by claims 8, 14, 20, and 23. As discussed in the Amendment of July 24, 2001, only claim 14 recites a storage device.

The Examiner's clarification of the use of Kight to teach the validation and/or alteration of a payor's account number with a payee, found in claims 8, 14, 20, and 23, is also appreciated. However, as argued in prior responses and the Appeal Brief, Kight does not teach such limitations. These prior arguments are expressly incorporated herein, and it is respectfully requested that the Examiner reconsider such arguments, as well as the discussion below.

The Examiner has further clarified the rejection of claim 23. As best understood, the Examiner now points to Kight at column 3, lines 32-35, and column 4, lines 33-35 and 47-49, as disclosing verifying and/or altering payor account numbers with a payee.

The referenced text in column 3 discloses a payor providing a merchant's name, address, and phone number and the consumer's account number with the merchant. The referenced text in column 4, lines 33-35, as discussed in previous responses, does generally disclose the need for validating and editing merchant account numbers. However, Kight does not disclose any particulars as to how validation and editing are performed. Specifically, Kight does not teach or suggest alteration rules or transforming a received account number according to alteration rules.

In regard to claims 9, 15, 21, and 24, the Examiner maintains the rejection, without providing the requested support for the Official Notice, that it is old and well known to process a merchant account number to identify one of a plurality of remittance centers.

The Examiner additionally argues that "when retrieving information from a database, it is common to use one entry to access a second entry in a database. For example, in the post office, if one inserts a person's name as an entry in a database, the address for the person would come up for delivery purposes." How this relates to the requirement of claims 9, 15, 21, and 24 that an account number be processed to identify one of a plurality of remittance centers is simply not understood.

With regard to pending claims 1-11 and 12-28, it is respectfully submitted that the following features clearly and patentably distinguish the over the applied prior art and Official Notice(s):

- processing the received payment information other than received payee zip code to identify an eleven digit zip code for a payee, and accessing the database of payee records to locate the payee record having the payee zip code corresponding to the identified eleven-digit zip code.

- receiving payment information including a payee zip code and other payee address information, and processing only a portion of the other payee address information to identify an eleven digit zip code.

- receiving payment information including a payee city and a payee state, and processing the received payee city and the payee state to identify an eleven digit zip code.

- A plurality of payee records stored in a database, each payee record having a payee name, receiving payment information including a payee name, and accessing the database to locate the payee record having the payee name and the zip code corresponding to only a portion of the received payee name and the identified eleven digit zip code.

- locating the payee record by matching the identified eleven digit zip code with the payee record zip code in the database, and matching the portion of the received payee name with a portion of the payee record name in the database.

- the database including alteration rules for altering the account number and validation rules corresponding to payee values for fields of the account number for validating the account number, verifying that the account number conforms to the validation rules, and transforming the verified account number into an altered account number according to the alteration rules.

- processing the account number to identify one of the plurality of remittance centers to which payment is to be remitted, and directing the payment and the altered account number to the identified remittance center.

- processing the received name, city and state information to identify an eleven digit zip code for a payee, and accessing the database of merchant records to locate the merchant record for the merchant corresponding to the identified eleven-digit zip code.

- a processor configured to process the payment information, excluding the received payee zip code, to produce an

eleven-digit zip code for the payee and to retrieve one or more of the plurality of payee records having an associated zip code corresponding to the eleven-digit zip code from the storage device code.
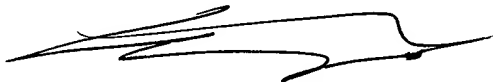
- software which causes a processor to process the payment information, excluding the received payee zip code, to identify an eleven digit zip code for the payee, and to access a database of payee records to locate a payee record corresponding to the eleven-digit zip code within a database.

- second station, coupled to the network, configured to receive the payment information from the first station via the network, process the payment information to produce an eleven digit zip code for the payee, and access the database to locate a payee record for the payee corresponding to the eleven digit zip code.

- determining if the stored payee name information and the stored payee address information included in any of the plurality of payee records correspond to the received payee name information and the received payee address information, directing payment in accordance with a first of the plurality of payee records if the stored payee name information and the stored payee address information included in the first payee record is determined to correspond to the received payee name information and the received payee address information, processing the received payee address information to identify an eleven digit zip code if none of the plurality of payee records include stored payee name information and stored payee address information which is determined to correspond to the received payee name information and the received payee address information, determining if the stored payee zip code included in any of the plurality of payee records corresponds to the identified eleven-digit zip code, and directing payment in accordance with a second of the plurality of payee records if the stored payee zip code included in the second payee record is determined to correspond to the identified eleven-digit zip code.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the 35 USC § 103(a) rejection of claims 1-11 and 13-28.

Accordingly, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-0427 and please credit any excess fees to such deposit account.

Respectfully submitted,

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14